

Serial No. 10/692,391

**REMARKS**

The Office action dated December 2, 2004 and the cited references have been carefully considered.

**Status of the Claims**

Claims 16, 17, and 21 are pending.

Claims 16, 17, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaylord (U.S. Patent 3,808,178). The Applicants respectfully traverse all of these rejections for the reasons set forth below.

**Remarks on the Amendments to the Claims**

Support for the limitation of "each R group comprises an aromatic group covalently attached to a linking group" in amended claims 16 and 21 is found, for example, in the non-limiting examples of the aromatic-based side groups disclosed in paragraph [0015] and Table 1 of the original specification. The Applicants wish to emphasize that although the scope of the claims is not limited by any particular embodiment of the claimed invention, a non-limiting method of synthesizing an aromatic-based siloxane macromonomer of the present invention is disclosed in paragraph [0016]. Such a macromonomer can be made by a two-step process. In the first step, a silicone hydride-containing macromonomer is made. In the second step, this silicone-hydride macromonomer is reacted with an allylic functionalized aromatic to attach the aromatic group to the silicon atom. Thus, the side group R comprises the aromatic group covalently attached to the linking group.

**Claim Rejection Under 35 U.S.C. § 103(a)**

Claims 16, 17, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaylord. The Applicants respectfully traverse this rejection because Gaylord does not teach or suggest all of the limitations of each of claims 16, 17, and 21.

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"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. § 2143.03 (8<sup>th</sup> ed., Rev. 2, May 2004).

Gaylord discloses only phenyl side groups. See; e.g., column 1, line 70 to column 2, line 6. In particular, Gaylord discloses triphenyldimethyldisiloxanylmethyl acrylate. Column 2, lines 45-50. In this teaching, the aromatic side group (phenyl) is attached directly to the silicon atom without any intervening linking group. Gaylor does not disclose any aromatic side groups other than phenyl.

In contradistinction, each of claims 16, 17, and 21 recites side groups R, each comprising an aromatic group covalently attached to a linking group. It is recognized by people skilled in the art that the properties of a polymer is significantly influenced by the configuration of the side groups. Thus, Gaylord's phenyl side groups are not expected to yield the same properties as the side groups of the instant claims. It is not pertinent whether Gaylord suggests the function of an aromatic-based substituent in increasing the refractive index if Gaylord does not describe or suggest its structure. *In re Mill*, 16 U.S.P.Q2d 1430, 1432-33 (Fed. Cir. 1990).

Since Gaylord does not teach or suggest a linking group between the side groups and the silicon atom, Gaylord does not teach or suggest all of the limitations of each of claims 18, 21, and 24. Consequently, these claims are patentable over Gaylord under 35 U.S.C. § 103(a).

In view of the above, it is submitted that the claims are patentable and in condition for allowance. Reconsideration of the rejection is requested. Allowance of the claims at an early date is solicited.

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Respectfully submitted,

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